

TAKAMI *et al.*, SN 10/811,910
Amdt. filed 10/28/2004
Reply to OA dated 7/28/2004

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REMARKS

This Amendment is responsive to the Office Action identified above, and is further responsive in any manner indicated below.

PENDING CLAIMS

Claims 17-46 were pending for examination and consideration in the noted application. Unrelated to any prior art, scope adjustment or rejection, appropriate claims have been amended in order to adjust a clarity and/or focus of Applicant's invention. That is, all such changes are simply clarified claims in which Applicant is presently interested. At entry of this paper, Claims 17-46 remain pending for consideration and examination in the present application.

NON-STATUTORY DBL. PAT. REJECT. - STATUTORY DISCLAIMER FILED

The obviousness-type double patenting rejection of Claims 17-30 as set forth in the section "Double Patenting" spanning pages 2 and 3 of the Office Action is respectfully traversed. However, in order to travel a path of least resistance to obtaining a patent for the present application, submitted herewith is an executed Statutory (Terminal) Disclaimer to overcome the non-statutory double patenting rejection. As a result of the foregoing, reconsideration and withdrawal of the double patenting rejection of the subject claims are respectfully requested.

The above statements, or the filing of any Statutory Disclaimer, should not be taken as an indication or admission that the rejection was valid, but is merely use of a procedural approach to obviate the rejection. Further, at this point, it is respectfully

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submitted as a reminder that, if new art is now cited against any of Applicant's unamended claims, then it would not be proper to make a next Action final.

NON-REWRITTEN ALLOWABLE CLAIMS

Although Claims 41 and 42 have been indicated as being allowable if rewritten as indicated in the section "Allowable Subject Matter on page 6 of the Office Action, rewriting has not yet been effected as it is believed that the base claim will be allowed responsive to this paper. Applicant respectfully reserves the right to rewrite the potentially allowable claims at a later time if necessary, and Applicant and the undersigned respectfully thank the Examiner for such indication of potentially allowable subject matter.

REJECTION UNDER 35 USC §102

The 35 USC §102 rejection of Claims 31-40 and 44-46 as being anticipated by Nagata *et al.* (US 4,959,788 A) is respectfully traversed. Such rejection has been rendered obsolete by the present clarifying amendments to Applicant's claims, and accordingly, traversal arguments are not appropriate at this time. However, Applicant respectfully submits the following to preclude renewal of such rejection against Applicant's clarified claims.

All descriptions of Applicant's disclosed and claimed invention, and all descriptions and rebuttal arguments regarding the applied prior art, as previously submitted by Applicant in any form, are repeated and incorporated herein by reference. Further, all Office Action statements regarding the prior art rejections are

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respectfully traversed. As additional arguments, Applicant respectfully submits the following.

At the outset, as to the requirements to support a rejection under 35 USC §102, reference is made to the decision of *In re Robertson*, 49 USPQ2d 1949 (Fed. Cir. 1999), wherein the Court pointed out that anticipation under 35 USC §102 required that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the Court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Moreover, the Court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. Therefore, the applied art does not adequately support a §102 anticipatory-type rejection because, at minimum, such applied art does not disclose (or suggest) the following discussed limitations of Applicant's claims.

More particularly, Applicant's disclosed and claimed arrangements are directed to lessening a number of key entries and burden on a user, but utilizing amount information provided by an external device and an IC card's lump-sum transacting button. As one example, as described in Applicant's FIG. 6 and on specification page 18, information on a value of electronic money which can be

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obtained from an external device (e.g., cash register) through a communication line

3. Then, when a lump-sum transacting button is depressed, control processing is performed for receiving all the value of the obtainable electronic money information from the other device through the modem unit 5 and the communication line 3.

Thus, if an owner runs a retail store utilizing a cash register which handled electronic money, upon nightly closing of the store, the owner can utilize the lump sum transacting button to conveniently move all of the electronic money within the cash register over to the IC card. The IC card can then be removed from the retail store for securing the financial electronic money.

One important point of the above is that the value of the electronic money is not keyboarded or entered by the user, but instead, is information supplied by an external device (e.g., cash register).

Turning now to rebuttal of the applied art, Nagata *et al.*'s arrangements require user keyboarding or entry of a transaction amount. That is, Nagata *et al.*'s arrangements do not utilize information on a value of electronic money obtained from an external device (e.g., cash register) in operation of a lump-sum transaction button.

In addition to the foregoing, the following additional remarks from Applicant's foreign representative are also submitted in support of traversal of the rejection and patentability of Applicant's claims.

In the reference to Nagata *et al.*, the payment amount is specified using keypad 12. The payment amount thus specified is remitted later by a single operation (see, e.g., Column 7, lines 18-29 of Nagata *et al.*).

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In Nagata *et al.*, inputting the payment amount and remitting that input amount are different operations performed separately with some time difference, and it is necessary to specify payment amounts every time remittances are made.

In contrast, the present invention as claimed in clarified Claims 31 and 32 can remit (or thaw) a predetermined amount by a single operation of lump sum transmission button. This eliminates the operation for inputting values of payment amounts to be transmitted (drawn) in lump sum. Such a feature is not taught or suggested by Nagata *et al.*

As explained above, in Nagata *et al.*, inputting a payment amount and the remitting of that payment amount are operations performed at separate times, and it is necessary to specify a payment amount by keypad every time the remittance is made.

In contrast, the present invention according to clarified Claims 33-40 and 44-46 can transmit (draw) a predetermined amount inputted from an external device in advance by operating a lump sum transmission button. Such a procedure eliminates the operation for inputting values of payment amounts to be transmitted (drawn) in lump sum. This feature also is not disclosed or suggested in Nagata *et al.*

As a result of all of the foregoing, it is respectfully submitted that the applied art would not support a §102 anticipatory-type rejection of Applicant's claims. Accordingly, reconsideration and withdrawal of such §102 rejection, and express written allowance of all of the §102 rejected claims, are respectfully requested. Further, at this point, it is respectfully submitted as a reminder that, if new art is now

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cited against any of Applicant's unamended claims, then it would not be proper to make a next Action final.

EXAMINER INVITED TO TELEPHONE

The Examiner is invited to telephone the undersigned at the local D.C. area number of 703-312-6600, to discuss an Examiner's Amendment or other suggested action for accelerating prosecution and moving the present application to allowance.

RESERVATION OF RIGHTS

It is respectfully submitted that any and all claim amendments and/or cancellations submitted within this paper and throughout prosecution of the present application are without prejudice or disclaimer of any scope or subject matter. Further, Applicant respectfully reserves all rights to file subsequent related application(s) (including reissue applications) directed to any/all previously claimed limitations/features which have been subsequently amended or cancelled, or to any/all limitations/features not yet claimed, *i.e.*, Applicant continues (indefinitely) to maintain no intention or desire to dedicate or surrender any limitations/features of subject matter of the present application to the public.

CONCLUSION


This Amendment is being submitted within the shortened statutory period for response set by the Office Action mailed 28 July 2004, and therefore, no Petition is required. To whatever other extent is actually necessary and appropriate, Applicant

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respectfully petitions for an appropriate extension of time under 37 CFR §1.136.
Form PTO-2038 attached hereto authorizes payment of the requisite Statutory
Disclaimer fee; no additional fees are required for entry of this paper. Please charge
any actual deficiency in fees to ATSK Deposit Account No. 01-2135 (as Case No.
566.35562CX3).

Respectfully submitted,



Paul J. Skwierawski
Registration No. 32,173
ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 North Seventeenth Street, Suite 1800
Arlington, Virginia 22209-3801, USA
Telephone 703-312-6600
Facsimile 703-312-6666

Attachments:

Statutory Disclaimer
Form PTO-2038 (Fee Code 1814)